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PATENT
Attorney Docket No.: 10517-37US

Assistant Commissioner for Patents
Washington, D.C. 20231

On

6-21-99

TOWNSEND and TOWNSEND and CREW LLP

By:

[Signature]

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

Volker Schmidt

Application No.: 08/836,369

Filed: May 13, 1997

For: TEMPERATURE-MEASUREMENT
INSTRUMENT WITH DIFFRACTIVE
OPTICS



Examiner: A. Hirshfield

Art Unit: 2859

DECLARATION OF CHARLES E.
KRUEGER UNDER 37 CFR §5.25

Assistant Commissioner for Patents
Washington, D.C. 20231

Sir:

I, CHARLES E. KRUEGER, hereby declare that:

1. I am a patent attorney (Reg. No. 30,077) and have represented Raytek Corporation (Raytek) in patent matters since about 1984. The following is a statement of supporting facts to support a conclusion that the Petition for a Retroactive Foreign Filing License was diligently filed.

2. On about April 3, 1997 I had a telephone conversation with Pete King, VP of Engineering of Raytek concerning patents issued to Omega Corporation relating to laser sighting devices used with infrared radiometers. During that conversation Mr. King mentioned the work of a Raytek engineer who had built a prototype of a laser sighting device for a radiometer. We also discussed a product being designed by the German Raytek subsidiary that utilized a diffraction grating as part of a laser sighting device. We also discussed Mr. King's

understanding that the product being developed in Germany was a continuation of the work started at Raytek's Santa Cruz facility.

3. On about June 29, 1997 I met with Cliff Warren, Chairman, President, and CEO of Raytek, Pete King, VP of Engineering of Raytek, and James Isbester, outside litigation counsel for Raytek. At that time the work of the Raytek engineer, William Menchine, concerning the laser sighting device was also discussed. Additionally, I was given information concerning the operation of the MX, the device being designed in Germany. I was also informed that German patent applications had been filed covering the MX. My understanding of the MX was that a diffraction grating and prism arrangement was used to create a "bow tie" configuration of laser beams that would accurately outline the energy zone at near and far fields. I did not have information concerning the subject matter claimed in the German patent applications. 4. The U.S. counterpart, S/N 08/836,369 ("the '369 patent application"), of the German patent MX patent application was filed on October 20, 1997 by Mr. John McCulloch of the Learman & McCulloch law firm in Michigan. This law firm was chosen by Mr. Tetzner, the German patent lawyer. I was not forwarded a copy of the patent application.

5. On May 20, 1998 responsibility for prosecuting the '369 patent application was transferred to me. I reviewed the content of the claims to respond to a restriction requirement. The elected claims recited a laser sighting device utilizing a diffraction grating.

6. On June 30, 1998 I met again with Messrs. Warren, King, and Isbester to discuss the Omega situation. We discussed the scope of the claims of the '369 patent application. We also discussed the possibility that the invention was a continuation of the work done by Mr. Menchine in Santa Cruz so that the German inventor, Volker Schmidt, and Mr. Menchine would have been co-inventors of the claimed laser sighting device utilizing a diffraction grating. It might therefore be necessary to add Mr. Menchine as a co-inventor on the '369 patent application.

7. Subsequent to June 30, 1998 meeting I realized that if, in fact, Messrs. Schmidt and Menchine were co-inventors, then a foreign filing license may have been required prior to filing the German patent application. I knew that no such license had been obtained. I then spoke to several attorneys at my firm concerning the procedures for obtaining a retroactive foreign filing license. I obtained the telephone number of the Director of the

Licensing and Review Branch of Group 2200. In July of 1998 I called the group and spoke to Don Walsh. I was informed that the petition to obtain a retroactive foreign filing license required a detailed factual basis explaining how the error occurred. At this time I was not in possession of these facts. I requested Mr. Isbester, who was in contact with Mr. Schmidt, to investigate whether the co-operation required for joint inventorship had taken place between Messrs. Schmidt and Menchine.

8. Our initial investigation was not determinative of whether Mr. Menchine should be a co-inventor on the '393 application and whether a foreign filing license was required were undetermined.

9. The details of the continued investigation by Mr. Schmidt are set forth in paragraphs 8-10 of the accompanying Schmidt declaration filed in connection with this petition. As stated therein, Mr. Menchine was added as an inventor to the German patent application in September 1998 based on the facts uncovered by Mr. Schmidt.

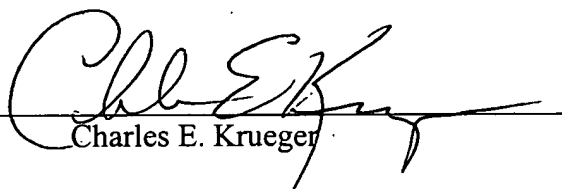
10. I had been informed by Mr. Walsh of Group 2200 that the petition should be supported by declarations from the patent attorneys that filed the patent application. Accordingly Mr. Isbester began preparing declarations for Mr. McCulloch and Mr. Tetzner, as well as a declaration for Mr. Schmidt.

11. As evidenced by Attachment A, draft declarations were completed and mailed on February 11, 1999. Since these were drafts prepared by Mr. Isbester, based on his understanding of the facts, I expected that several revisions might be needed before the declarations were executed. Also, I believed that extra delays would result due to Mr. Schmidt and Mr. Tetzner's being located in Germany.

12. Accordingly, I decided to file the petition for a retroactive filing license on February 11, 1999 in order to meet the diligence requirement. Although the declarations had not yet been executed I believed that the facts were well enough understood to support the declaration. My intent was to supplement the petition with the executed declarations when they were received.

I further declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of the application or any patent issuing thereon.

Dated: June 21, 1999


Charles E. Krueger